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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,186	02/26/2002	Mario Galasso	SOM-GAL-P1	8209

7590

07/30/2003

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EXAMINER

BOEHLER, ANNE MARIE M

ART UNIT

PAPER NUMBER

3611

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/086,186		GALASSO, MARIO	
	<b>Examiner</b>		<b>Art Unit</b>	
		Anne Marie M Boehler	3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

1. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2, "such as" is an indefinite term.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Moore.

Moore shows a telescoping bicycle suspension including a steering tube 2, a crown 10, stanchion tubes 3, and slider tubes 5. The stanchion tubes slide within the slider tubes and both sets of tubes have a generally elliptical cross-sectional shape (see Figure 3) which does not permit relative rotational movement.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Lin.

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Moore shows the aspect ratio of the elliptical cross section that appears to be approximately .5, rather than .7 and it is silent regarding the actual dimensions of the tubing.

Lin teaches using tubular frame members in a bicycle frame whereby the tubular members have an elliptical shape with an aspect ratio of approximately .7. It also indicates that the maximum dimension of the rear fork members may range from 40mm to 75mm (1.5 to 3 inches, which would make the smaller dimension between 1 and 2 inches).

It would have been obvious to one of ordinary skill in the art to dimension the Moore to have an aspect ratio of about .7 and have cross sectional dimensions of, for example 1 inch and 1.5 inches, as taught by Lin, in order to optimize the cross sectional shape. Moore is also silent regarding the length of the stanchions, however, it would have been an obvious design choice to make the stanchions approximately 8-12 inches long with three inches of travel, in order to accommodate the dimensions of standard mountain bikes.

6. Claims 1, 2, 6-12, 14-16, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawahara in view of Moore.

Kawahara shows a bicycle front suspension with an external bushing 26 fixed to the slider 16 and an internal bushing 24B mounted to the lower end of the stanchion, as claimed. The external bushing caps the upper end of the slider and has a tapered internal dimension which provides a graduated gap between the inner surface of the bushing and the external surface of the stanchion.

Kawahara lacks an elliptical cross section for the stanchion and sliders.

Moore teaches forming telescoping front bicycle suspension tubes with an elliptical cross section.

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It would have been obvious to one of ordinary skill in the art to form the Kawahara telescoping members with elliptical cross sections, as taught by Moore, in order to make the suspension more aerodynamic and stronger in the direction in which load is applied.

7. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pileggi and Wilson show telescoping members with upper and lower bushings therebetween.

Haag, Hartmann and Lampel show front fork members having elliptical cross sections.

Girvin shows a front fork member with a non-circular cross section.

McJunkin shows telescoping bicycle frame members having elliptical cross sections.

Isono shows that it is an obvious alternative to make bicycle frame members elliptical rather than circular, square or rectangular (Figs. 9-12).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie M Boehler whose telephone number is 703-308-0422. The examiner can normally be reached on 7:30-5:00, Monday-Thursday, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703-308-0629. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

*AMB* 7/21/03

Anne Marie M Boehler  
Primary Examiner  
Art Unit 3611

amb  
July 21, 2003